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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,139	12/07/2006	David J. Ross	CAF-35502/03	4935
25006	7590	10/05/2009		
GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C			EXAMINER	
PO BOX 7021			DEXTER, CLARK F	
TROY, MI 48007-7021				
			ART UNIT	PAPER NUMBER
			3724	
			MAIL DATE	DELIVERY MODE
			10/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,139	Applicant(s) ROSS ET AL.	
	Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 5-39 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/22/06; 10/19/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-4 and 40) in the reply filed on July 9, 2009 is acknowledged. Claims 5-39 and 41 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statements filed on November 22, 2006 and October 19, 2007 have been received and the references listed thereon have been considered.

Claim Objections

4. Claim 40 is objected to because of the following informalities:

In claim 40, line 6, "a inner" is improper grammar.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 2nd paragraph

5. Claims 1-4 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, the recitation "mountable" renders the claims vague and indefinite as to what is being set forth, particularly as to whether the cutting assembly is mounted on the body, and it seems that it should be changed to "mounted".

In claim 3, line 2, each of the first and second occurrences of "an inner face" is vague as to whether it refers to that previously set forth or to another such inner face.

In claim 40, line 5, the recitation "mountable" renders the claims vague and indefinite as to what is being set forth, particularly as to whether the cutting assembly is mounted on the body, and it seems that it should be changed to "mounted".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Isaac, pn 2,264,840.

Isaac discloses a device with every structural limitation of the claimed invention including:

a body (e.g., a human body); and

a cutting assembly mountable on the body (e.g., on the hands of the human body) and comprising first and second relatively moveable cutting members (e.g., 11, 12) each defining a cutting edge and an inner face, wherein the first and second cutting members are adapted to permit cooperation between the respective cutting edges to cut by a shearing action while maintaining the inner faces in non-engaging relationship to provide clearance therebetween (e.g., as shown in Figs. 3-6);

[claim 2] wherein the first and second cutting members of the cutting assembly are arranged such that during a cutting operation the cutting edges are aligned with a projected cutting plane;

[claim 3] wherein each of said first and second cutting members includes an inner face, an inner face of at least one of the cutting members being inclined outwardly from a projected cutting plane in order to provide clearance between the inner faces when the cutting assembly is operated;

[claim 4] wherein the inner face of each cutting member is outwardly inclined from the projected cutting plane in order to provide clearance between said faces when the cutting assembly is operated.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Isaac, pn 2,264,840.

Isaac discloses a device with almost every step of the claimed method including: providing a cast cutter including:

a body (e.g., a human body as implied thereby);

a cutting assembly mountable on the body and comprising first and second relatively moveable cutting members (e.g., 11, 12) each defining a cutting edge and a inner face, wherein the first and second cutting members are adapted to permit cooperation between the respective cutting edges to cut by a shearing action while maintaining the inner faces in non-engaging relationship to provide clearance therebetween (e.g., as shown in Figs. 3-6).

Isaac lacks the application of the device to cut a cast including the steps of: manipulating the cast-cutter to position a cast material to be removed from a patient between the first and second cutting members; and

activating the cast-cutter to cause relative movement of the first and second cutting members to cause the cast material to be cut by cooperation of the cutting edges.

However, the Examiner takes Official notice that using shears to cut a cast is old and well known in the art and that shears in general are used to cut the material of a cast to remove the case or undesired portions of the cast. Numerous examples of such a use are widely known. Further, the use of the particular type of shears disclosed by Isaac, namely tin snips, would have been when facing the problem of cutting a cast with

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only those shears available. Therefore, it would have been obvious to one having ordinary skill in the art to perform the method of cutting a cast with the shears of Isaac for well known reasons including those discussed above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cfd
September 28, 2009